

REMARKS

This Application has been carefully reviewed in light of the Office Action dated July 23, 2008 ("*Office Action*"). Claims 1-33 are pending. The *Office Action* rejects Claims 1-12 and 16-33, and objects to Claims 13-15. Applicants currently cancel Claims 2, 13, and 24 without prejudice or disclaimer, and amend Claims 1, 3, 5, 6, 12, 16-23, 25, 27, and 28 to correct informalities and hasten issuance of allowable subject matter as suggested by the Examiner. No new matter is added. Applicants respectfully request reconsideration and favorable action in this case.

I. Allowable Subject Matter

The Examiner objects to Claims 13-15 as dependent upon a rejected base claim. Applicants appreciate the Examiner's indication that these claims would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. P. 11. To hasten issuance of allowable subject matter, Applicants amend independent Claim 12 to incorporate the limitations of dependent Claim 13 and cancel Claim 13. Accordingly, Applicants respectfully request full allowance of Claims 12 and 14-22 as they are in condition for allowance.

Pursuant to 37 C.F.R. § 1.104, Applicants respectfully issue a statement commenting on the Examiner's reasons for allowance. Applicants respectfully disagree with the Examiner's reasons for allowance to the extent that they are inconsistent with applicable case law, statutes, and regulations. Furthermore, Applicants do not admit to any characterization or limitation of the claims, particularly any that are inconsistent with the language of the claims considered in their entirety and including all of their constituent limitations or any characterization of a reference by the Examiner.

II. Claim Objections

The *Office Action* objects to Claims 2, 5, 6, 13, 16, 17, 24, 27, and 28 due to informalities. P. 2.

Regarding Claims 2, 13, and 24, the *Office Action* asserts that the claim language "recovery response times" should read "response times" in order to be consistent with the terminology found in Applicants' specification. P. 3. To advance prosecution of this Application, Applicants currently amend Claims 1 (which incorporates the limitations of canceled Claim 2), 12 (which incorporates the limitations of canceled Claim 13), and 23

(which incorporates the limitations of canceled Claim 24), to correct informalities as suggested by the Examiner.

Regarding Claims 5, 6, 16, 17, 27, and 28, the *Office Action* asserts that the claim language “failure obligation” should read “remote node obligation” or “protection obligation” in order to be consistent with the terminology found in Applicants’ specification. P. 3. To advance prosecution of this Application, Applicants currently amend Claims 5, 6, 16, 17, 27, and 28 to correct informalities as suggested by the Examiner.

III. Rejections Under 35 U.S.C. § 101

The *Office Action* rejects Claims 1-11 under 35 U.S.C. § 101 as directed to non-statutory subject matter and argues that “[t]he claimed method for provisioning protection paths is not tied to another statutory class (such as a particular apparatus) nor transforming underlying subject matter (such as an article or materials) to a different state or thing.” *Office Action*, p. 3. The *Office Action* further states that “[t]o qualify as § 101 statutory process, the claim should positively recite the other statutory class (e.g., the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps.” *Id.*

The Board of Patent Appeals and Interferences has confirmed that methods or processes, such as those recited in independent Claim 1, are patentable subject matter. “[A]ll that is necessary, in our view, to make a sequence of operational steps a statutory “process” within 35 U.S.C. § 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of “useful arts.” Const. Art. 1, sec. 8.” See *Ex Parte Lundgren*, Appeal No. 2003-2088, 2004 WL 3561262 (Bd. Pat. App. & Interf., April 20, 2004) (citing *In re Musgrave*, 431 F.2d 882, 893, 167 U.S.P.Q. 280, 289 (CCPA 1970)).

Accordingly, Applicants respectfully submit that, as written, Claims 1-11 are directed to statutory subject matter. Thus, Applicants respectfully request reconsideration and allowance of Claims 1-11.

IV. Rejections Under 35 U.S.C. § 112

The *Office Action* rejects Claims 6, 17, and 28 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as their invention. P. 4. Specifically, the *Office Action* states that “[t]here is a lack of antecedent basis for “the failure obligations” in the claim language, as the rejected claims depend on independent claims 1, 12, and 23 and not on Claims 5, 16,

and 27.” P. 4. To advance prosecution of this Application, Applicants currently amend Claims 6, 17, and 28 to depend on Claims 5, 16, and 27, respectively, as suggested by the Examiner.

The *Office Action* rejects Claims 23-33 under 35 U.S.C. § 112, second paragraph, as incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. P. 4. Specifically, the *Office Action* states that “[t]he omitted structural cooperative relationships are between the claimed network interface, memory, and controller in independent Claim 23.” P. 4.

Applicants respectfully submit that a rejection under 35 U.S.C. § 112, second paragraph, for omitting essential steps (or essential structural cooperative relationships of elements) is proper if the claim “fails to interrelate essential elements of the invention as defined by applicant(s) in the specification.” See M.P.E.P § 2172.01, citing *In re Venezia*, 530 F.2d 956 (C.C.P.A. 1976) (emphasis added). Even if each claim element is not interrelated (which Applicants do not concede), “it is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result.” See *Ex parte Nolden*, 149 U.S.P.Q 378, 380 (Bd. Pat. App. 1965). “A claim does not necessarily fail to comply with 35 U.S.C. § 112, second paragraph where the various elements do not function simultaneously, are not directly functionally related, do not directly intercooperate, and/or serve independent purposes.” See *Ex parte Huber*, 148 U.S.P.Q. 447, 448-49 (Bd. Pat. App. 1965).

With respect to Claims 23-33, the *Office Action* fails to provide any support for the contention that any omitted structural cooperative relationships of elements were defined by the specification as necessary structural connections. For at least these reasons, Applicants request that the rejection of Claims 23-33 under 35 U.S.C. § 112, second paragraph, be withdrawn.

V. Claim Rejections Under 35 U.S.C. §§ 102 and 103

The *Office Action* rejects:

- Claims 1, 5, 6, 8, and 11 under 35 U.S.C. § 102(b) as anticipated by U. S. Patent Application Publication No. 2002/0172149 issued to Kinoshita et al. (“*Kinoshita*”);

- Claim 7 under 35 U.S.C. §103(a) as unpatentable over *Kinoshita* in view of U. S. Patent Application Publication No. 2002/0006112 issued to Jaber et al. (“*Jaber*”);
- Claims 9, 12, 16, 17, 19, 20, 22, 23, 27, 28, 30, 31, and 33 under 35 U.S.C. §103(a) as unpatentable over *Kinoshita* in view of U.S. Patent No. 7,170,851 issued to Chen et al. (“*Chen*”);
- Claim 10 under 35 U.S.C. §103(a) as unpatentable over *Kinoshita* in view of U. S. Patent No. 6,992,978 issued to Humblet (“*Humblet*”);
- Claims 18 and 29 under 35 U.S.C. §103(a) as unpatentable over *Kinoshita* in view of *Chen*, as applied to Claims 12 and 23 above, and further in view of *Jabor*; and
- Claims 21 and 32 under 35 U.S.C. §103(a) as unpatentable over *Kinoshita* in view of *Chen*, as applied to Claims 12 and 23 above, and further in view of *Humblet*.

Although Applicants respectfully traverse these rejections, Applicants currently amend independent Claims 1, 12, and 23 to hasten issuance of currently allowable subject matter. Specifically, based on the indication in the *Office Action* that Claim 13 contained allowable subject matter, Applicants amend all independent claims – Claims 1, 12, and 23 – to include this allowable subject matter. Applicants therefore respectfully request reconsideration and allowance of independent Claims 1, 12, and 23, and their respective dependent claims.

CONCLUSION

Applicants have made an earnest attempt to place the Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of this Application.

If the Examiner feels that a telephone conference or an interview would advance prosecution of the Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Although no fees are believed to be currently due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants

A handwritten signature in black ink, appearing to read 'Kurt M. Pankratz', with a stylized flourish at the end.

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